

"Differences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter. n8 Under section 103, the board cannot dissect a claim, excise the printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable. The claim must be read as a whole."

Thus, printed matter that is an element of claim must be accorded patentable weight just like any other element.

The *In re Gulack* court also explained that:

"Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability. Although the printed matter must be considered, in that situation it may not be entitled to patentable weight. "

Thus, only in those situations where the printed matter is not functionally related to the other elements of the claim will the printed matter not carry patentable weight. Importantly, if the printed matter is functionally related to the other elements of the claim, the printed matter does carry patentable weight and the printed matter must be considered in determining patentability, just like any other element of the claim.

One situation where printed matter was considered to be functionally related to the other elements of a claim is where the claim was directed to a measuring device and the printed matter on the side of the measuring device provided indications of the amounts of material in the measuring device. In this situation, the court found that the printed material was functionally related to the other elements of the claim because it told how to use the other elements of the claim. See *In re Miller*, 57 C.C.P.A. 809, 418 F.2d 1392, 164 U.S.P.Q. (BNA) 46. Similarly, the *In re Gulack* court found that numbers printed on bands in a mathematical device imparted patentability to the device in that they told how use the device in a way different from the prior art and therefore were functionally related to the device.

In the present case, the instructions are a separate and important element of the claimed kit because they tell how to use the other components of the kit. Because the instructions tell how to use the other kit elements in a way that is different from the prior art, they are functionally related to the other kit elements. Since they are functionally related to the other kit elements, they must be accorded patentable weight just like the other kit elements. As such, the Examiner is in error in failing to accord the claimed instruction elements any patentable weight and must treat the claimed instruction element just like any other element.

Turning now to an analysis of whether the claimed invention (giving the instructional element its due consideration of holding patentable weight just like any other element), it is well established that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987), *cert. denied*, 481 U.S. 1052 (1987). *See also, Scripps Clinic and Research Foundation v. Genentech, Inc.*, 18 USPQ 2d 1001 (Fed. Cir. 1991).

In the present case, Martindale fails to teach the instructional element of the present claims. As such, Martindale fails to teach each and every element of the claims.

Because Martindale fails to teach each and every element of the claimed kit, e.g., the instructions, Martindale fails to anticipate Claims 1-6 under 35 U.S.C. § 102(b) and this rejection may be withdrawn.

In addition, the Examiner has rejected Claims 1-20 under 35 U.S.C. § 102(e) as being anticipated by Hausheer. In making this rejection, the Examiner again accords the recited instructional material no patentable weight. As demonstrated above, the recited instructional element must be accorded patentable weight just like any other element. Since Hausheer fails to teach the claimed instruction element, Hausheer fails to teach each and every limitation of the claimed invention and this rejection may be withdrawn.

As such, this application is considered to be in good and proper form for allowance and the Examiner is respectfully requested to pass this application to issuance.

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16 and 1.17 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 50-0815.

Respectfully submitted,
BOZICEVIC, FIELD & FRANCIS LLP

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By: 

Bret E. Field
Registration No. 37,620

BOZICEVIC, FIELD & FRANCIS LLP
200 Middlefield Road, Suite 200
Menlo Park, CA 94025
Telephone: (650) 327-3400
Facsimile: (650) 327-3231

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